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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/067,594 | 02/05/2002 | Thomas Falone | INNERCORE-4 | 5901 |

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VOLPE AND KOENIG, P.C.
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

EXAMINER

GRAHAM, MARK S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 05/12/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/067,594

Applicant(s)

FALONE ET AL.

Examiner

Mark S. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 12, 18-21, 25, 29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Minami. The material of which Minami's layers are constructed will dissipate force and thus meets the "force dissipating material" limitations.

Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Lau. Lau's layer 12 will dissipate force and thus meets the "force dissipating material" limitations.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Minami in view of Falone '617 (Falone). Minami does not disclose the exact hardness of his grip material. However, as disclosed by Falone it is known in the art to construct such grips of the hardness claimed.

Claims 6, 17, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minami in view of Belli. Miami discloses the claimed invention with the exception of the use of aramid fibers as a force dissipating material. However, it is known in the art to use such fibers in grips to dissipate force. Note Belli at paragraph 8, 13, and 40. It would have been obvious to one of ordinary skill in the art to have used such in Minami's grip as well to help dissipate force.

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Regarding claim 17, note that Belli teaches that rackets are suitable candidates for grips such as Minami's or Belli's.

Claims 7, 10, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau in view of Minami. Lau discloses the claimed grip with the exception of the relative hardnesses of the inner and outer layers. However, as disclosed by Minami the use of the relative hardnesses claimed is known in the art. It would have been obvious to one of ordinary skill in the art to have used such relative hardnesses for Lau's inner and outer layers as well to achieve the results desired by Minami.

Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 7 above, and further in view of Belli. Claims 8, and 11 are obviated for the reasons explained above with the possible exception of the type of mesh used. Lau does not detail his fabric 14. However, as disclosed by Belli it is known in the art to use a mesh fabric in such devices to help dissipate force. It would have been obvious to one of ordinary skill in the art to have used the same for Lau's fabric to help dissipate force.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 7 above, and further in view of Kwitek. Claim 9 is obviated for the reasons explained above with the possible exception of the type of mesh used. Lau does not detail his fabric 14. However, as disclosed by Kwitek it is known in the art to use a discontinuous fabric in such devices to help dissipate force. It would have been obvious to one of ordinary skill in the art to have used the same for Lau's fabric to help dissipate force.

Claims 13, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minami in view of Uffindell '254 (Uffindell). Minami discloses the claimed device with the

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exception of its use on a baseball bat. However it is commonly known that such grips are applied to bats as well to allow the batter to obtain a suitable grip as typified by Uffindell. It would have been obvious to one of ordinary skill in the art to have used such a grip on a bat as well to obtain the advantages of Minami's grip.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Minami in view of Pennell. Minami discloses the claimed grip with the exception of how it is applied to a club. Minami uses a tube construction but it is commonly known in the art to use a wrapped tape construction as well. It would have been obvious to one of ordinary skill in the art to have supplied Minami's grips in this manner as well if such were a preferred application technique by the user.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lau in view of Uffindell. Lau discloses the claimed device with the exception of covering a handle knob. However, as disclosed by Uffindell such a construction is known in the art. It would have been obvious to one of ordinary skill in the art to have applied Lau's grip in the same manner if it was desired to cover the entirety of the handle portion of the bat.

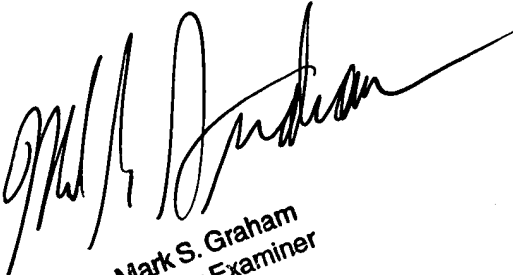
Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uffindell in view of Kwitek. Uffindell discloses the claimed grip with the exception of the fibers. However, as disclosed by Kwitek it is known in the art to use such fibers in grips to help provide shock absorption and to provide a tacky surface. It would have been obvious to one of ordinary skill in the art to have incorporated such in Uffindell's grip as well to improve its capabilities.

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Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lau in view of Belli. Lau discloses the claimed device with the exception of the use of aramid fibers. However, as disclosed by Belli such fibers are known in the art to help dissipate force. It would have been obvious to one of ordinary skill in the art to have used such fibers as Lau's fibers as well to help dissipate force.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 703-308-1355.

MSG
4/28/03



Mark S. Graham
Primary Examiner